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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/659,645 | 09/12/2000 | Robert Hugh Smithson | NAI1P155/99.079.01 | 6976 |

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EXAMINER

NOBAHAR, ABDULHAKIM

| ART UNIT | PAPER NUMBER |
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2132

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary

Application No.

09/659,645

Applicant(s)

SMITHSON ET AL.

Examiner

Abdulhakim Nobahar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-13, 18-20, 23-30, 35-37 and 40-47 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 14-17, 21, 22, 31-34, 38, 39 and 48-51 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

“sequence data defining a sequence containing a plurality of predefined actions to be followed upon detection of said outbreak” in claims 1, 18 and 35;

“one of said predefined actions is reducing virus detection notifications” in claim 6;

“one of said predefined actions is switching from virus quarantining to virus deletion when a computer virus is detected” in claims 7, 24 and 41;

“one of said predefined actions is increasing scan options that control how thoroughly said computer system is scanned to detect a computer virus” in claim 8;

“one of said predefined actions is sending a copy of said detected computer virus to a remote site for analysis” in claims 9, 26 and 43;

“one of said predefined actions is downloading a latest virus definition file from a remote site” in claims 10-11, 27-28 and 44-45.

“one of said predefined actions is performing a complete virus scan of all computer files stored in at least a portion of said computer apparatus” in claims 12, 29 and 46;

“one of said predefined actions is blocking e-mail attachments” in claims 13, 30 and 47;

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"one of said predefined actions is rendering non-accessible e-mail distribution lists and e-mail address books of e-mail clients coupled to said computer apparatus" in claims 15, 32 and 49;

"of said predefined actions is restarting in administrator mode an e-mail post office coupled to said computer apparatus" in claims 16, 33 and 50; and

"one of said predefined actions is closing down an e-mail post office coupled to said computer apparatus" in claims 17, 34 and 51, must be shown or the features canceled from the respective claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because they are illegible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1-3, 6, 8-9, 12, 18-20, 23, 25-26, 29, 35-37, 40, 42-43 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold et al. (5,440,723; hereinafter Arnold).

4. Regarding claims 1, 18 and 35, Arnold discloses a method for automatically detecting and eliminating an undesirable software entity such as a virus in a computer system or in a network of computer system (see, for example, col. 2, lines 27-42). Arnold also discloses that the method includes sequence of steps (corresponding to the recited plurality of predefined actions) to be taken for preventing the spread of virus in a computer or a computer network (see, for example, col. 2, Summary of the Invention, col. 4, lines 29-59 and Fig. 2).

5. Regarding claims 2-3, 19-20 and 36-37, Arnold discloses that the computer user is notified and an action is taken upon user desire (corresponding to the recited user defined or user input confirming said predefined action) (see, for example, col. 5, Summary of the Invention, col. 4, lines 14-26 and col. 10, lines 41-55).

6. Regarding claims 6, 23 and 40, Arnold discloses a mechanism for informing the neighboring computers after detecting a virus in a computer system (corresponding to the recited virus detection notification) in order to prevent the spread of the virus (see, for example, col. 19, lines 45-57). Arnold further discloses that precautions are taken to inform only the non-infected computers not every computer in the network (col. 20, lines 12-21). This precautionary measure to limit the informing signals in the network corresponds to the recited reducing virus detection notifications.

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7. Regarding claims 8, 12, 25, 29, 42 and 46, Arnold discloses a scanning mechanism for scanning all information in all the relevant media in order to detect known viruses (i.e., thoroughly scanning the computer system) (see, for example, col. 5, lines 29-45).

8. Regarding claims 9, 26 and 43, Arnold discloses that a copy of the newly detected unknown virus is sent to a virus expert for analysis and to distribute its signature in the next release of the anti-virus software (see, for example, col. 26, line 65-col. 27, line 20).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 10-11, 13, 24, 27-28, 30, 41, 44-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. (5,440,723; hereinafter Arnold) in view of Kim et al. (6,701,440 B1; hereinafter Kim).

11. Regarding claims 7, 24 and 41, Arnold does not expressly disclose the deletion of a detected computer virus after the step of quarantining the virus. Kim, however, teaches a method for protecting a computer network by detecting e-mail viruses before the e-mail message is sent to its destination in the network (see, for example, abstract).

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Kim further teaches that the infected incoming e-mail message is quarantined in a remote server and then after all or an infected portion of the e-mail is deleted (see, for example, col. 3, lines 25-62).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to implement the virus-quarantining step prior to the deletion of the detected virus as taught in Kim in the method of Arnold, because it would prevent the outbreak of virus infection via the e-mail transmission in a network of computer (col. 3, lines 11-17).

12. Regarding claims 10-11, 27-28 and 44-45, Arnold teaches a periodic update of anti-virus software (col. 2, lines 1-11 and col. 13, lines 7-18) but does not expressly teaches downloading a latest virus definition from a remote site. Kim on the other hand teaches updating anti-virus software by downloading the profile of a new virus from a remote site (col. 2, line 5-15 and col. 7, lines 38-60).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to implement the downloading step of a new virus definition as taught in Kim in the method of Arnold, because it would prevent the outbreak of virus infection via the e-mail transmission in a network of computer (col. 3, lines 11-17).

13. Regarding claims 13, 30 and 47, Kim teaches a mechanism that the user has the option to block certain e-mail (see, for example, col. 6, lines 48-64).

Allowable Subject Matter

14. Claims 4-5, 14-17, 21-22, 31-34, 38-39, and 48-51 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,889,943 to Ji et al.

US Patent No. 5,809,138 to Netiv

US Patent No. 5,948,104 to Gluck et al.

US Patent No. 6,401,120 B1 to Templeton

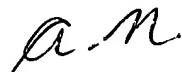
US Patent No. 6,347,375 B1 Reinert et al.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Abdulhakim Nobahar
Examiner
Art Unit 2132

AN
March 30, 2004